

Exhibit

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VOL. I, PAGES 1 - 224

2 IN THE UNITED STATES DISTRICT COURT

3 FOR THE DISTRICT MASSACHUSETTS

4 CIVIL ACTION NO. 03-CV2428-WGY

5

6 BRAUN, GmbH

7 Plaintiff

8 v.

9 RAYOVAC CORPORATION ,

10 Defendant

11

12 - - - - -

13 Deposition of Samir Nayfeh, Ph.D.

14 Friday, August 26, 2005

15 8:58 a.m.

16 Ropes & Gray

17 One International Place

18 Boston, Massachusetts

19 - - - - -

20 Reporter: Deborah Roth, RPR/CSR

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ORIGINAL

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1 design should be able to understand all of these
2 patents.

3 Q. Okay. I guess that's where I do have some
4 confusion then.

5 I mean, in particular, the Lee patent,
6 would that be within the art of the patents-in-suit?

7 A. Could you remind which one is Lee?

8 Q. Tool-cleaning apparatus. Do you have your
9 second report?

10 MS. WENDLANDT: Page 23 of your second
11 report, Exhibit 151.

12 A. Oh, okay.

13 So Braun had said that it was not
14 analogous art.

15 Whether it's analogous for this -- is
16 there a strict definition of the term "analogous,"
17 "analogous art," in other words?

18 I haven't really, anywhere in here,
19 rendered an opinion on it, or really considered it as
20 a question that I have analyzed.

21 Q. So you haven't considered whether Braun's
22 argument as to whether it was analogous or not --
23 analogous art -- well, you do not offer an opinion as
24 to whether or not the Lee patent is or is not

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1 analogous art; is that correct?

2 A. Well, I haven't offered an opinion, I don't
3 think.

4 Q. Let's take a step back to the level of skill
5 in the art.

6 I guess there may be agreement between
7 you and Mr. Phillips as to the level of skill.

8 For someone who lacks a formal education,
9 what type of experience would you expect that
10 individual to possess?

11 A. I would say, again, experience in mechanical
12 design.

13 Q. And, again, mechanical design of any
14 products?

15 A. Yeah. I would say broadly, unless the
16 person's experience was so narrow as to not provide
17 them any background in the basic elements of what is
18 going on here, but I would say typically someone with
19 a few year's experience in mechanical design would
20 have enough background to understand what is going on
21 here.

22 Q. When you say "the basic elements of what is
23 going on here," what do you mean those basic
24 elements?

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1 apparatus?

2 A. No.

3 Q. Why not?

4 A. Shaving is cutting hairs off down to the
5 skin. Hair clippers don't do that.

6 Q. Have you ever use hair clippers before?

7 A. Yes.

8 Q. And it doesn't shave down to the skin?

9 A. No.

10 Q. So, in your opinion, shavings has to be
11 cutting down to the skin, that is a shaving
12 apparatus?

13 A. Yes.

14 Q. I believe it is also your opinion that a hair
15 clipper is not a dry shaving apparatus as well? That
16 would be your opinion as well, correct?

17 MS. WENDLANDT: Objection.

18 A. Correct.

19 Q. If you see in Figure 3, there is shown a
20 razor 42. Do you see that?

21 A. Yes.

22 Q. Is razor 42 a shaving apparatus?

23 A. Yes.

24 Q. Look back to the upper paragraph at the top.

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1 You would be looking for a device that
2 dries and is asking the person, the user of the
3 device to do the drying separately, seems not to fall
4 within the claims.

5 Q. And what specific portion of the -- what
6 specific language in Claim 11 makes it fall outside
7 of the claims?

8 A. Well, in other words, your cleaning devices
9 comprises all of these things.

10 So the towel on the side, I don't see as
11 part of this cleaning device, and it would just seem
12 bizarre to claim that it's providing a towel so
13 somebody would constitute having an invented a drying
14 device.

15 Q. So you think it's -- the language that you
16 are pointing to precludes that the towel hypothetical
17 is a cleaning device in Claim 11?

18 A. Well, I think if we said a cleaning device
19 comprising a set of those elements, and one of those
20 elements being a drying device, then you would look
21 for a device that is comprised within the cleaning
22 device that does the drying.

23 Q. Are you aware that the parties have agreed
24 that the preamble to Claim 11 is not a limitation in

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1 the case?

2 MS. WENDLANDT: Objection.

3 A. Yes. I'm aware of that.

4 Q. So it is your opinion that -- let me ask
5 again then.

6 What language in Claim 11 specifically
7 precludes my towel hypothetical?

8 MS. WENDLANDT: Objection.

9 Q. Let me ask again. What language in Claim 11
10 specifically precludes my towel hypothetical from
11 falling within the scope of Claim 11's coverage?

12 MS. WENDLANDT: Objection.

13 A. You need a device that is part of the machine
14 as far as I can tell.

15 The word "device" implies some mechanism,
16 something, some item and some physical object, and
17 all of these elements are components of this system,
18 and to sort of import the function of drying to
19 something outside of the system itself, I don't think
20 anybody skilled in the art would ever consider
21 somebody wiping a towel on the thing after you have
22 taken it out of the machine to be the drying device.

23 Q. So you point me to the word "device" in Claim
24 11; is that correct?

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1 MS. WENDLANDT: Objection.

2 A. At least the word "device."

3 Q. Is there any other language that you can see,
4 sitting here today, that precludes my hypothetical
5 from falling within the scope of Claim 11?

6 A. I think the word "comprising," whether or not
7 you consider "a cleaning device comprising" to be a
8 limitation, I think is meaningful.

9 Q. So, any other language?

10 A. I think that's it for specific language.

11 Q. What if Rayovac began selling its cleaning
12 base, and also had in a larger box a handheld fan,
13 and included an instruction book that said, "use this
14 fan to dry off the head of the shaver after
15 cleaning," would that fall within the scope of Claim
16 11?

17 A. No.

18 Q. And why not?

19 A. Repeat of the argument for the towel. Same
20 principle.

21 You are asking somebody -- you are using
22 something that is not part of the cleaning device to
23 do the drying. Whether it is a towel or hair dryer,
24 it's not important.

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1 Q. Okay. So that -- the words "a drying device"
2 don't place any limitation on where the drying device
3 is; is that correct?

4 MS. WENDLANDT: Objection.

5 A. On their own, no.

6 Q. So with respect to these series of questions
7 regarding my hypotheticals, the language you would
8 rely on is "a cleaning device comprising"; is that
9 correct?

10 MS. WENDLANDT: Objection.

11 A. So, yeah, the cleaning device has to comprise
12 a drying device in addition to the other elements.

13 Q. Let's just stay on this topic. If you should
14 turn to Page 18 of your expert report.

15 A. Okay.

16 Q. You speak there, in some detail, regarding
17 this louvered shutter system; is that correct? It
18 starts at Page 18 --

19 A. Correct.

20 Q. -- but it continues on.

21 Where in Claims 11 and 12 of the '328
22 patent do we find this louvered shutter system?

23 A. We don't.

24 Q. So why, then, are you discussing the louvered

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1 shutter system in connection with obviousness?

2 A. Because when you look at obviousness, you ask
3 what would it take for the inventors to make this
4 invention?

5 The inventors couldn't have written the
6 claim that requires a drying device unless they could
7 have written a document which would enable one
8 skilled in the art to incorporate a drying device
9 into the cleaning system.

10 Q. So absent the louvered shutter system, the
11 cleaning device with a -- the cleaning system with a
12 drying device would not work?

13 MS. WENDLANDT: Objection.

14 A. What I was pointing to was that they couldn't
15 have written that claim unless they had taught you
16 some means of incorporating the drying device into
17 the cleaning system.

18 So when you look at obviousness, you
19 can't just look at the claims. You have to look at
20 the active invention, and the active invention
21 includes being able to write the enabling document.

22 Q. What is your understanding of what you are
23 supposed to be comparing for purposes of the
24 obviousness analysis?

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1 A. I don't see it as strictly a comparison.

2 Q. Okay. When you were rendering your opinions
3 on obviousness, you weren't comparing the claims to
4 the prior art?

5 MS. WENDLANDT: Objection.

6 A. You're not comparing strictly the claims.

7 You're looking at the claim in the
8 context of the overall invention and asking whether
9 the active invention was obvious.

10 Q. And what is the active invention?

11 A. The active invention is conceiving of what is
12 claimed and enabling what is claimed.

13 Q. So when you were opining on obviousness, you
14 were considering the claims and the specification
15 against the prior art; is that right?

16 A. Yes.

17 Q. And did counsel explain to you what you were
18 supposed to consider in connection with your
19 obviousness analysis?

20 A. I think when I first wrote this, we hadn't
21 discussed it, and it's just things that I had learned
22 in previous experiences.

23 Q. Turn back to Page 4.

24 MS. WENDLANDT: Jim, if this is an okay

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1 correct?

2 A. At least that. I don't remember if there is
3 anything else.

4 Q. There is also the point -- you also mention
5 the point about the clipper blades, too, and that's
6 not the shaving head of a shaving apparatus?

7 A. Yes.

8 Q. But one of your opinions, like McKinley and
9 Davies, is that grid 17 and tank 10 do not have a
10 particular shape; is that correct?

11 A. Correct.

12 Q. And that's where at the bottom of this
13 paragraph you say, "Such surfaces cannot properly be
14 called cradle structures and are not adapted to
15 receiving a shaving head of the shaving apparatus"?

16 A. Correct.

17 Q. Now, have you -- you've also considered that
18 the '556 patent in connection with this litigation;
19 is that correct?

20 A. Yes.

21 Q. And you're aware that the '556 patent
22 explicitly calls out a dry shaving apparatus; is that
23 correct?

24 A. Yes.

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1 Q. And are you also aware that the '328 patent
2 does not explicitly require a dry shaving apparatus?

3 A. Yes.

4 Q. And with respect to the drying device element
5 of the Maatz patent at the bottom of this page --

6 A. Yes.

7 Q. -- your opinion is that the drain hole 22 is
8 not a drying device; is that correct?

9 A. Correct.

10 Q. If you took the drain hole 22 out of the --
11 well, if you plug the drain hole 22 in the Maatz
12 patent, would it take longer for the cleaned tools to
13 dry?

14 A. Yes.

15 Q. So does the drain hole aid in the drying of
16 the barber's tools, cleaned barber tools?

17 A. I think the word is it is a prerequisite for
18 the drying of those tools.

19 Q. Do you see a distinction there?

20 Well, do you see a distinction between
21 being a prerequisite for drying the tools and aiding
22 in the drying of the tools?

23 A. I think so.

24 I mean, if you said, "aid," I guess in

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1 cleaning fluid container within the agreed
2 construction of the parties?

3 MS. WENDLANDT: Objection.

4 A. Yes.

5 Q. And is it your understanding that that spray
6 can would have been similar to the -- is it your
7 understanding that the spray can that Dr. Pahl
8 procured would be similar to the spray can 60 of the
9 Loeffler patent?

10 MS. WENDLANDT: Objection.

11 A. I can't say.

12 Q. You also note with respect to the spray can
13 in 60 of the Loeffler patent, in the last sentence,
14 you state, "As is clear from Figure 1 of the Loeffler
15 patent reproduced immediately above, there is no
16 provision to catch or contain the contaminated fluid
17 that would drain from the shaving head in a fluidic
18 cleaning operation."

19 Do you see that?

20 A. Yes.

21 Q. Can you point me to where in the language of
22 Claim 14 there is any requirement of a provision to
23 catch or contain contaminated fluid?

24 A. It's only implied.

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1 Q. And implied within the construction of
2 cleaning fluid container?

3 A. Yes. And possibly elsewhere. Yeah. It's
4 implied when you say "cleaning fluid."

5 Q. Let me ask you this: You're aware that
6 Rayovac sells its product with a bottle of cleaning
7 fluid; is that correct?

8 A. Yes.

9 Q. And is that bottle of cleaning fluid a
10 cleaning fluid container?

11 A. Yes.

12 Q. And you are also aware that the fluid is
13 poured out of that bottle into Rayovac's device,
14 correct?

15 A. Correct.

16 Q. And you're also aware that the contaminated
17 fluid is not poured back into that bottle; is that
18 correct?

19 MS. WENDLANDT: Objection.

20 A. It could be, but probably not. You wouldn't
21 expect to.

22 Q. So, let me ask, also, as well: They sell
23 detergent for mops, for cleaning dishes and perhaps a
24 floor in containers; is that correct? Are you aware

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1 of those?

2 A. Correct.

3 Q. And are those cleaning fluid containers, a
4 bottle of dishwasher detergent?

5 A. Yes.

6 Q. Do people return the dishwasher detergent to
7 the bottle after the detergent has been used for
8 cleaning?

9 MS. WENDLANDT: Objection.

10 A. No.

11 Q. Could you look at the feed device element,
12 Part 11 of your report?

13 A. Yes.

14 Q. You opine that the feed device element is not
15 met by the Loeffler patent?

16 A. Yes.

17 Q. You also state that valve 75 is a flow
18 control device?

19 A. Yes.

20 Q. What is the difference between a feed device
21 and a flow control device?

22 A. So the feed device, as we mentioned,
23 exemplified by the pump and conduits, and possibly
24 other components, includes that thing which provides

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1 connection with the prosecution of the '328 patent
2 disclose a bracket for insertion of a shaving
3 apparatus therein?

4 A. I don't know. I really only addressed the
5 ones that were raised by Mr. Phillips.

6 Q. Okay. And at the bottom of Page 21, you
7 state, "More importantly, even if Mr. Zeischke had
8 drawn a bracket into which the electronic shaver
9 could be inserted for storage and charging, this
10 would not have taught a bracket into which the shaver
11 could be inserted during cleaning."

12 Do you see that?

13 A. Yes.

14 Q. Where in Claim 18 of the '328 patent is there
15 a requirement that the shaver has to be inserted into
16 the bracket during cleaning? And, again, I am
17 emphasizing "during cleaning" part of the statement.

18 A. So, again, it's not literally there, but
19 clearly from the specification when the bracket is
20 described, it's -- the bracket is -- you insert into
21 the bracket during the cleaning operation.

22 Q. Above that, in the paragraph above that, you
23 note that the rectangles, which I think are called
24 park positions, serve only to indicate the general

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1 ports.

2 Q. So fluid does not go from the cleaning fluid
3 container to the supporting surfaces 3C directly; is
4 that correct?

5 A. As we discussed, it is shot into, or at, at
6 least, the shaving head, and then makes it way down
7 there and possibly gets those wet.

8 MR. SHIMOTA: Why don't we take a brief
9 break.

10 THE VIDEOGRAPHER: Going off the record.

11 The time is 3:37.

12 (A recess was taken.)

13 THE VIDEOGRAPHER: One moment. We are
14 back on the record. The time is 3:46.

15 Q. We were talking a little bit about
16 infringement.

17 I know you offered opinions with respect
18 to literal infringement; is that correct?

19 A. You might want to clarify what you mean.

20 Q. Sure. Are you familiar with the term the
21 "doctrine of equivalence"? Have you ever encountered
22 that before?

23 A. I have read about it a bit, but I haven't
24 done any detailed opinions on that.

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1 Q. So I take it you have not offered any
2 opinions that Rayovac's devices infringe under the
3 doctrine of equivalence; is that correct?

4 A. I don't think so.

5 Q. In your reports, do you offer any -- well, do
6 you offer any opinion, assuming that the court
7 modifies its "cradle structure" construction as
8 suggested by Mr. Phillips and now Rayovac?

9 MS. WENDLANDT: Opinion as to?

10 Q. Opinion as to infringing -- infringement --
11 let me rephrase that question.

12 In your reports, is there any opinion
13 offered as to whether or not Rayovac's devices
14 infringe, if the court's "cradle" construction is
15 modified as suggested by Mr. Phillips?

16 A. The only modification being to require
17 receive and retain?

18 Q. Yes.

19 A. I don't think I have offered an opinion on
20 that, as I recall.

21 Q. Okay. So that opinion would not be found in
22 either your first or your third expert report?

23 A. I don't think so.

24 Q. Okay.

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1 MR. SHIMOTA: I would like to mark
2 Defendant's Exhibit 165, your third expert report.

3 EXHIBIT NO. 165 MARKED

4 Q. And most specifically to Page 13, when you
5 talk about the substitutes.

6 MS. WENDLANDT: Just to clarify for the
7 record, mine has Jesse Davies report as well.

8 Should we take that out?

9 MR. SHIMOTA: Yes.

10 MS. WENDLANDT: Is that Page 62 of the
11 fax?

12 MR. SHIMOTA: Yes. We can do that. I'm
13 not going to ask you about it. We can do it off the
14 record. I guarantee you I won't ask you about that,
15 because I haven't read it closely.

16 Q. What is your -- what is the analytical
17 framework you applied for assessing whether
18 noninfringing -- acceptable noninfringing substitutes
19 were available to Rayovac?

20 A. I really just responded to what Mr. Phillips
21 had written.

22 Q. Okay. I am focusing on -- you make the
23 statement, and you have a prelude paragraph, and you
24 state, at the last sentence, "Or more importantly, at

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1 the time it began making its first infringing devices
2 in the fall of 2003."

3 Do you see that?

4 A. Yes.

5 Q. Why do you think that fact is
6 significant?

7 A. Well, just my understanding that that the
8 substitutes would have had to have been available at
9 the time that the infringement occurred.

10 Q. Okay. Do you understand that in assessing
11 whether substitutes would be available you are to
12 assume that Rayovac knew that it wouldn't be able to
13 sell devices as are currently configured? Rayovac
14 had that information available to it?

15 A. We would assume that Rayovac knew that it was
16 infringing on a valid patent.

17 Q. Knew that it could not --

18 A. Okay. Uhm, I didn't know that.

19 Q. Okay. You refer to on Page 14 a passive
20 drying. Do you see that?

21 A. Right.

22 Q. I believe you state, "There is no reason to
23 believe" -- at the end of the first paragraph --
24 "Therefore, it would be acceptable to consumers now."

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1 A. I don't recall seeing any such report.

2 Q. You can't comment on what you have not seen?

3 A. Yes. Yes.

4 Q. If you heard about it, maybe you could.

5 One last question. Are you aware that

6 Mr. Phillips opines upon, how it referred to, as

7 secondary considerations of nonobviousness in his

8 report?

9 A. I seem to recall that, yes.

10 Q. Am I correct that you do not offer any
11 opinions on secondary considerations of
12 nonobviousness, right?

13 A. I don't recall having done so.

14 At most, I might have quoted somebody. I
15 don't recall giving any opinions on that.

16 Q. I mean, can you say one way or the other
17 whether you have?

18 A. To be definitive, I would have to read --

19 MS. WENDLANDT: Jim, we can stipulate
20 that if it is not in the report, he hasn't opined on
21 it, or he can sit here and read it.

22 Q. I don't want you to read it.

23 A. I could be proven wrong, because I have
24 thought about these issues, but I don't recall